

Appl. No.: 10/767,471
Atty. Docket No.: CL1505ORD

REMARKS

Status of the claims

By entry of the above amendment, claims 39-40, 49-50, and 59-60 are canceled (claims 1-35, 37-38, 47-48, and 57-58 were previously canceled); claims 36, 44, 46, 54, 56, 64, 66, 70-72, and 74 are amended; and claims 91-108 are added. As such, claims 36, 41-46, 51-56, and 61-108 are currently pending. No new matter is introduced by this amendment, and its entry is respectfully requested. A current claim listing is presented above with appropriate status identifiers for each claim, in accordance with 37 C.F.R. §1.121(c).

New claim rejection: 35 USC §112, 2nd paragraph, indefiniteness

Claim 74 was rejected under 35 USC §112, 2nd paragraph, as it is unclear over recitation of the phrase 'said T allele or said A allele'. The Examiner states that the rejected claim is dependent on claim 74, and claim 74 depends from any of claims 36, 46, or 56, and in so far as the rejected claim depends from claim 46, where claim 46 recites properties of a C/C or G/G genotype, there is no antecedent basis for the required T or A alleles.

As an initial matter, it is presumed that the Examiner intended to indicate that claim 76 is rejected, rather than claim 74, since it is claim 76 that recites the phrase 'said T allele or said A allele' (and claim 76 depends from claim 74, which depends from any of claims 36, 46, or 56).

In response, claim 74 is hereby amended so as to only depend from claim 36 and no longer from claim 46 (as well as no longer depending from claim 56). This amendment to claim 74 obviates the presumed rejection of claim 76 under 35 USC §112, 2nd paragraph (indefiniteness). Additionally, a corresponding amendment is hereby presented to add new claims 91-93 (dependent from claim 46), and its entry is respectfully requested.

New claim rejection: 35 USC §112, 1st paragraph, written description (new matter)

Claims 73 and 85-90 were rejected under 35 USC §112, 1st paragraph (written description), because these claims recite the limitation that a provided report is specifically 'in paper form', which is considered new matter.

In response, Applicants assert that a report being provided in paper form is at least conventional in the art and implicit in the specification, and thus is not new matter. For example, it is

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conventional and well-established in the art that the results of a genetic test can be conveyed to, for example, the individual whose nucleic acid sample was tested, their medical practitioner(s), a laboratory that performs the test, and/or any other test requestor. It is conventional not only in the art, but in the everyday world in general, that for the results of a test (not just a genetic test but other types of test) to be conveyed, the results can be reported on paper so that a tangible record of the results exists and can be provided to an individual to whom the results of the test are to be conveyed. Moreover, Table 6 provided in the instant patent application, which was filed in paper form, is an implicit example of results of an analysis of SNPs for association with rheumatoid arthritis being reported in paper form.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the new matter rejection of claims 73 and 85-90 under 35 USC §112, 1st paragraph (written description).

Maintained claim rejection: 35 USC §112, 1st paragraph, scope of enablement

The rejection of claims 36, 39-46, 49-56, and 59-90 under 35 USC §112, 1st paragraph (scope of enablement) was maintained. In maintaining this rejection, the Examiner states that the claims are enabled for methods in which particular nucleotide content is detected and indicative of RF+ RA risk, but in the instant case, the claims recite method of 'testing for the presence or absence' of a SNP, and thus do not have a step wherein any particular content is required to be detected.

In response, claims 36, 46, and 56 are hereby amended to clearly indicate the nucleotide content that is detected.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 36, 46, and 56 (and claims 39-45, 49-55, and 59-90 dependent therefrom) under 35 USC §112, 1st paragraph, scope of enablement.

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Conclusions

In conclusion, in view of the amendments and remarks above, Applicants submit that the present application is fully in condition for allowance.

The Examiner is invited to contact the undersigned via telephone if a phone interview would expedite prosecution of the instant patent application.

Respectfully submitted,

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